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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/678,408 | 10/02/2003 | Thomas J. Karol | 101221-651 | 9995 |
| 27387 | 7590 | 01/19/2006 | EXAMINER | |
| NORRIS, MCLAUGHLIN & MARCUS, P.A. 875 THIRD AVE 18TH FLOOR NEW YORK, NY 10022 | | | MCAVOY, ELLEN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1764 | |

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/678,408 | KAROL ET AL. | |
| | Examiner | Art Unit | |
| | Ellen M. McAvoy | 1764 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-17 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Horodysky (4,389,322) or Horodysky et al (4,478,732) or Horodysky et al (4,594,171) or Doner et al (5,068,045) in combination with Karol et al (6,806,241).

Applicants' arguments filed 10 November 2005 have been fully considered but they are not persuasive. As previously set forth, the Horodysky et al ["Horodysky"] references and the Doner et al ["Doner"] reference disclose borated derivatives of ethoxylated amides which are effective friction reducing additives in lubricating oil and grease compositions. Suitable lubricating oils include mineral and synthetic hydrocarbon oils of lubricating viscosity, and the amount of additive compound in the lubricant composition ranges from about 0.1% to about 10% by weight. The lubricant compositions may also include conventional lubricant additives such as ashless dispersants, detergents, anti-wear/extreme pressure agents, viscosity index improvers and the like, without effecting the performance of the borated ethoxylated amides. See column 5, line 64 to column 6, line 3, of Horodysky (4,478,732). The examiner maintains the position that component (1), an organo borate ester composition, is taught by the references outlined above. The antiwear composition of the claims additionally contains component (2), one or more components selected from (i) a thiadiazole compound of formula (I); (ii) a bisdithiocarbamate

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compound of formula (II); (iii) dithiocarbamates of formula (III) or (IV); (iv) phosphorodithioates of formula (V); (v) phosphorodithioate esters of formula (VI); and (vi) a non-sulfur molybdenum additive. However, all of the component (2) additives are known in the lubricating oil art as evidenced by Karol et al ["Karol"]. See column 2, line 20 to column 6. Karol also teaches the addition of borated alkoxylated amines to the lubricating oil composition as friction modifiers. See col. 6, lines 40-49. Thus it would have been obvious to the skilled artisan to have combined the references to arrive at the claimed lubricant additive compositions. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the disclosure in Horodysky and Doner allowing for the addition of conventional lubricant additives to the compositions such as ashless dispersants, detergents, anti-wear/extreme pressure agents, viscosity index improvers and the like, without effecting the performance of the borated ethoxylated amides.

Applicants argue that:

"The examiner suggests that it would have been obvious to simply combine the teachings of the prior art references in order to arrive at the claimed invention. However, applicant pointed out in the specification that neither the boron compounds nor the additives alone possess sufficient antiwear protection. Accordingly, the skilled person would not have been motivated to improve antiwear protection by combining these references."

This is not deemed to be persuasive since the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. Thus, it is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), cert. denied, 500 U.S. 904 (1991). Additionally, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicants also argue that:

“The unexpected synergism with respect to antiwear protection is clearly displayed in the extensive test data set forth in the specification.”

This is not deemed to be persuasive because the test data presented is not commensurate in scope with the degree of protection sought by the claims, i.e., every additive claimed in every amount. In several examples it is not clear that synergistic results have been demonstrated; it could simply be that component (2) has antiwear properties which component (1) lacks in that specific amount. Further, it is also noted in several examples that certain combinations of components (1) and (2) FAIL the antiwear tests such as in Table 2, examples 15 and 16.

THIS ACTION IS MADE FINAL. Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

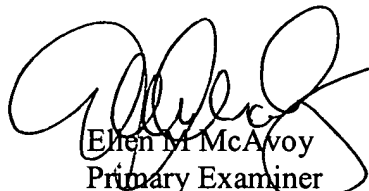
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
January 12, 2006